

REMARKS

The Office Action mailed May 25, 2005, has been received and its contents carefully considered. The Examiner has made a restriction requirement requiring election under 35 U.S.C. Section 121 between the following claim groups:

Group I: Claims 1-17, drawn to an inductor, classified in class 336, subclass 200; and

Group II: Claims 18-26, drawn to a method of forming an inductor, classified in class 29, subclass 602.1.

The Examiner confirms that the inventions in Groups I and II are related as process of making and product made. However, the Examiner contends that these claim groups are distinct because the inductor defined by the claims in Group I could be made by other methods than those set forth in the claims of Group II. The Examiner further contends that restriction is proper because the inventions in Groups I and II have acquired separate status in the art as shown by their different classifications. Applicants respectfully disagree.

To show that a process of making and a product made by the process are distinct inventions, the Examiner has the burden of providing an example of how the product, as claimed, can be made by another and materially different process. If Applicants can provide a convincing argument that the example suggested by the Examiner is not workable, the burden is on the Examiner to suggest another viable example or withdraw the restriction requirement. MPEP Section 806.05(f).

In the instant case, the Examiner contends that the inductor's conductor structure can be pre-formed by encapsulating the conductors in a green ceramic material that is then fired, and that this is a materially different process than as claimed in the claims of Group II. Applicants

respectfully disagree.

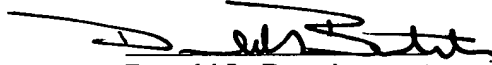
The problem with the Examiner's example is that neither independent Claim 1, which is directed to the inductor, nor independent Claim 18, which is directed to the method for forming the inductor, includes any limitation regarding how the conductors are formed or placed on the surface of the PCB. The step of preassembling (pre-forming) the conductors into a single unit is only claimed in dependent claims in each group. See, e.g., Claims 16 and 17, dependent from Claim 1, and Claim 19, dependent from Claim 18. Consequently, Applicants respectfully submit that the Examiner's suggested example fails to show that Claims 1 and 18 are distinct inventions, and thus, this example fails to support the Examiner's restriction requirement. That is, the broadest claim in each Group, as defined by the Examiner, does not include the limitation found in the example on which the Examiner's restriction requirement is based. It is therefore respectfully submitted that restriction under 35 U.S.C. Section 121 is not proper in this case. Withdrawal of the restriction requirement is therefore respectfully requested.

Applicants further respectfully disagree that the claimed inventions in Groups I and II have obtained separate status in the art as shown by the different classifications identified by the Examiner, i.e., class 336, subclass 200 for Group I and class 29, subclass 602.1 for Group II. Applicants respectfully submit that these two different classifications do not illustrate a separate status in the art for the following reason. Class 336, subclass 200 is directed to inductor coil or coil turn supports or spacers wherein the coil is a printed circuit type. Class 29, subclass 602.1 is directed to methods of manufacturing electromagnets, transformers or inductors. Applicants respectfully submit that each of these classifications is pertinent to the subject matter covered by the claims in the other specified Group. In other words, pertinent art may be located for the inductor of Group I in class 29, subclass 602.1, and similarly, pertinent art may be located for the process of Group II in class 336, subclass 200. As such, the search required for Group I is also required for Group II, and vice versa. Consequently, Applicants respectfully submit that search and examination of the entire application, i.e., both Groups I and II, can be made without serious burden. Consequently, on this basis as well, restriction is not proper in this case. See MPEP Sections 803 and 808.02.

For the foregoing reasons, Applicants respectfully submit that the restriction requirement is improper and should be withdrawn pursuant to 37 CFR Section 1.143. Should the Examiner believe a conference would be of benefit in expediting the prosecution of the instant application, the Examiner is hereby invited to telephone counsel to arrange such a conference.

Respectfully submitted,

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